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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087425,766	04/19/95	GREENE R	017220.0115

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QM61/1015

EXAMINER
TINKER, S

ART UNIT	PAPER NUMBER
3744	#16

DATE MAILED: 10/15/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/425,766

Applicant(s)
Greene et al

Examiner
Susanne Tinker

Group Art Unit
3404



☒ Responsive to communication(s) filed on Sep 20, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Henry Bennett
Supervisory Patent Examiner
Group 3700

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3744

Claims 1-20 are rejected under the equitable Recapture Doctrine as set forth in MPEP 1412.02. A synopsis of the Recapture Doctrine, especially in light of the recent C.A.F.C. decision in Hester Industries Inc. v. Stein Inc., 46 USPQ2d 1641 (1998), and how it applies to this application follows.

If a patentee tries to recapture what it previously surrendered in order to obtain allowance of original patent claims, that deliberate withdrawal or amendment cannot be said to involve the inadvertence or mistake contemplated by 35 USC 251 and is not an error of the kind which will justify the issuance of a reissue patent which included the matter withdrawn. The **recapture rule** bars a patentee from acquiring, through reissue, claims that are of the same scope or of broader scope than those claims that were canceled from the original application. In this regard, addition of narrowing limitations to a claim to overcome prior art is considered the full equivalent of cancellation of the claim and substitution of a narrower scope claim to overcome the prior art. See *Mentor Corp. V. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993).

However, the **recapture rule** will not bar a patentee from securing a reissue claim that is broader in a material respect than a canceled claim when the reissue claim is also narrower than the canceled claim in a way that is material to the "error" sought to be corrected by reissue. *Patacell v. U.S.*, 12 USPQ2d 1440 (U.S. Claims Court 1989). The recapture rule is based on the premise that when a patent applicant seeks to secure a patent by responding to a rejection of a claim by canceling or narrowing the scope of the claim, the applicant's intent is normally presumed. I.e., that the claim was canceled or narrowed based on a deliberate judgment that the claim as originally drafted was unpatentable. It necessarily follows that a deliberate judgment that a claim is unpatentable would constitute a deliberate judgment that a broader claim is also unpatentable. But, when the reissue claim is narrower than the canceled claim in a material respect, a similar conclusion as to the patentee's intent and, therefore, as to the absence of "error" cannot be made exclusively on a comparison of the reissue claim with the canceled claim. The fact that a particular claim is unpatentable over prior art does not mean that a claim that is narrower in some respect but broader in other respects also would be unpatentable. The addition of a particular limitation can result in an otherwise unpatentable claim becoming patentable. Therefore, one cannot assume that when an applicant canceled a claim that the applicant made a deliberate judgment that a second claim that is narrower in a certain respect and of the same or broader scope than the canceled claim is also unpatentable.

Thus, when a reissue claim is narrower than the canceled claim in a way that is material to the alleged "error" supporting reissue, it is not possible to conclude from a comparison of claim

Art Unit: 3744

scope alone that no "error" was involved in the patentee's failure to include a claim of the general scope of the reissue claim of the original patent. Based on this analysis, the Court of Claims held that where, as in this case, the reissue claim was not only broader in some aspects, but narrower than the canceled patent claim to which it corresponds **in a way that is material to the "error" sought to be corrected by reissue**, the recapture rule should not bar that reissue claim.

In Hester Industries Inc. v. Stein Inc., the C.A.F.C. extended the recapture doctrine to not only apply in cases where applicant has made amendments to claims in the original prosecution indicating critical subject matter, but also to apply to situations where applicant made arguments that subject matter included in the claims is critical. Id. at 1641. Such arguments, even if not accompanied by amendment, can give rise to a finding that the subject matter has been surrendered. The court in Hester held that the equitable principles serving as a foundation for estoppel notions apply equally to the context of recapture.

Applying these principles to the facts of this reissue application:

Applicant seeks to remove the following language from claim 1:
a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fire exhaust gases to reduce the quantity of CO, NO, and SO contained in said fired exhaust.

Applicant also seeks to remove similar language from claim 15, the only difference being the particular compounds removed from the exhaust gases.

However, the removal of this language is barred by the equitable "recapture" doctrine. In the patent sought to be reissued, the patentee argued that this claim language sought to be removed rendered the claims patentable over the prior art cited and applied in the rejection of those claims.

In the patent file, paper No. 5, filed August 19, 1991, on page 4, the patentee argued that the prior art failed to teach or mention a liquid filter arrangement as described and claimed by applicants, in that it did not mention a chemical treatment to reduce the quantity of CO, NO, SO, HCl or SO₂ as is required by applicant's claims

Furthermore, in the patent file in the Appeal Brief filed 10/29/92, applicant also argued the liquid filter element being a novelty of the patented invention which distinguishes it from the prior art.

Although, as Applicant asserts in his latest response of 9/30/97 in this reissue application, Applicant argued that the liquid filter means was only one of three independent limitations that

Art Unit: 3744

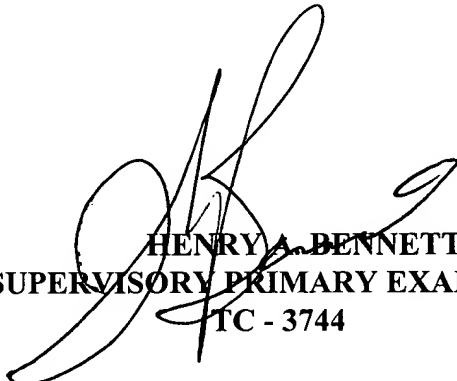
distinguished Applicant's invention from the prior art, it is the Examiner's position that the contents and circumstances surrounding the Examiner's "Reasons for Allowance" filed with the paper #20 in the original patent prosecution still serve to invoke the recapture doctrine in the present application. Specifically, the Examiner's Reasons for Allowance cited the liquid filter element as the critical subject matter rendering the claims allowable over the prior art of record. Applicant failed to file any contrary remarks in response to the Examiner's statement of reasons for allowance, an option that is explicitly made available to applicants when the examiner has provided reasons for allowance. Consequently, Applicant's lack of response is regarded as an agreement with the examiner's asserted reasons for allowance, that is, the liquid filter element as the critical patentable limitation. As such, Applicant has effectively surrendered the subject matter of the liquid filter element as reasoned by the court in Hester.

Thus, applicant is seeking to "recapture" subject matter which was surrendered during the original prosecution of the claims. This is improper and cannot be permitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanne Tinker whose telephone number is (703) 308-2637.


SCT

October 4, 1998


HENRY A. BENNETT
SUPERVISORY PRIMARY EXAMINER
TC - 3744